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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/672,430

09/26/2003

Charley M. Pollock

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06/14/2006

INTERNATIONAL PAPER COMPANY
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EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,430

Applicant(s)

POLLOCK ET AL.

Examiner

Ellen M. McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16 and 18-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 18, 20, 21, 25, 27, 28, 32, 34, 35, 39, 41 and 42 is/are rejected.
- 7) ☒ Claim(s) 19, 22-24, 26, 29-31, 33, 36-38, 40 and 43-45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Upon additional review, consultation and search, the **FINAL** Rejection made in the previous office action is withdrawn in view of the newly applied prior art rejections set forth hereinbelow. The amendment presented in the response to the **FINAL** Rejection IS entered and the pending claims are 1-14, 16, 18-45.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jevne et al (5,176,956).

Jevne et al ["Jevne"] discloses an improved biomedical appliance having disposed on at least a portion thereof a layer, film or body of a polymeric, adhesive composition consisting essentially of a reaction product of (1) a substantially difunctional, fatty acid or fatty acid derived dimer, and (2) a compatible polymer-forming co-reactant selected from diols, polyols, diamines, etc. See column 1, line 58 to column 2, line 8. The difunctional fatty acid derived dimers are produced by the dimerization of unsaturated, long chain fatty acid monomers having 9-20 carbon atoms, preferably 18 carbon atoms, and preferably prepared from tall oil fatty acids. See column 3, lines 14-35. Jevne teaches that the product dimer acids include a mixture of 36-carbon atom dibasic acids, 54-carbon atom tribasic acid, 18 carbon atom monomer reactant and

unpolymerized but structurally modified 18 carbon atom monobasic fatty acid. Thus it is to be understood that the term “dimer” used in Jevne is intended to include all the potential reaction products outlined above. See column 3, lines 50-65. Thus the examiner is of the position that the unreacted acids of the “dimer” product of Jevne meet applicants’ definition of “Monomer”. The dimer acids of Jevne are further reacted with (2) a co-reactant including diols and polyols. The product may optionally be reacted with (3) a glycerol cross-linking agent. The examiner is of the position that the reaction products of Jevne inherently contain polyol Monomerate, polyol monoMonomerate, polyol diMonomerate and mixtures thereof.

Claim Rejections - 35 USC § 103

Claims 1-14, 16, 18, 20-21, 25, 27-28, 32, 34-35, 39 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturwold et al (3,769,215).

Sturwold et al [“Sturwold”] disclose ester lubricant compositions derived from the reaction product of polyoxyalkylene glycols with a dibasic acid mixture consisting of dimer acids and short-chain dibasic acids. The dimer acids are prepared from monocarboxylic unsaturated acids containing from about 16 to 26 carbon atoms. Sturwold teaches that mixed acid products are used which contain 75 weight % or more of dimers and the remainder being unpolymerized fatty acids or more highly polymerized acids such as trimer acids. See column 3, lines 28-55. Thus 25% of the dimer products contain unreacted fatty acids and trimers. Thus the examiner is of the position that the unreacted acids of the dimer product of Sturwold meet applicants’ definition of “Monomer”. The dimer reaction product of Sturwold is further reacted

with polyoxyalkylene glycols and small amounts of other reactants including diols and polyols. See column 4, lines 31-43. The examiner is of the position that the reaction products of Sturwold inherently contain polyol Monomorate, polyol monoMonomorate, polyol diMonomorate and mixtures thereof. The ester products of Sturwold may be added to aqueous emulsions or solutions in a range from about 0.1 to 25% by weight. See column 2, lines 60-64. The lubricant compositions may be used as metal working fluids. See column 5, lines 40-53.

Allowable Subject Matter

Claims 19, 22-24, 26, 29-31, 33, 36-38, 40, 43-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

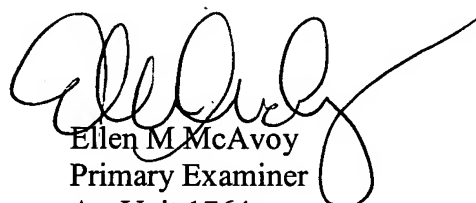
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1764

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ellen M. McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
June 9, 2006